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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,433	03/23/2000	David L. Patton	80521F-P	1516

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EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 10/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/534,433

Applicant(s)

PATTON, DAVID L.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12, 14, 18-23, 25 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 14, 18-23, 25 and 29-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 12, 14, 18-23, 25 and 29-34 have been amended for further examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12, 14, 18-23, 25, and 29-34 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Gasper et al in view of St. Louis Post-Dispatch Article in further view of the Ottawa Citizen.

Gasper et al discloses in Fig. 1 and 1A, a document (10, which could be considered a stamp or a sheet of stamps, as stated in Col. 5, lines 46-58) comprising a visible first indicia (12) identifying document (Col.5, lines 47-50), a second indicia (16) made using ink that can be seen when viewed under UV or infrared light (Col. 9, lines 19-24), not visible under normal viewing conditions (Col. 6, lines 15-23) and incapable of being scanned for reproduction (Col. 8, lines 63-67).

However, Gasper et al does not disclose a stamp comprising: a first indicia being a unique ID which identifies that the limited edition postal stamp is one out of a predetermined limited number; a third indicia for identifying the printer or location of where the stamp was printed, wherein the third indicia is not visible under normal viewing conditions, incapable of being scanned for reproduction, and wherein the ink can be viewed under UV or infrared light.

St. Louis Post-Dispatch discloses a limited edition stamp of 2000 stamps comprising indicia to show that each stamp is sequentially numbered and labeled as "the Governor's Edition.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gasper et al's document to be in the form of a stamp

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comprising unique indicia as taught by the St. Louis Post-Dispatch for the purpose of providing a limited edition stamp.

However Gasper et al as modified by the St. Louis Post Dispatch does not disclose a limited edition stamp for postal usage.

Ottawa Citizen discloses a limited edition stamps which are to be used for official postage.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gasper et al's and the St. Louis Dispatch's stamp with an limited edition official postal stamp as taught by the Ottawa Citizen for the purpose of the stamp to be used for postal usage.

In regards to **Claims 12, 19, 23 and 30, 34**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any desirable indicia on the stamp document, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate. Furthermore, the fact that the content of the printed matter placed on the substrate may render the device more unique by providing an individual with a "specific type of article" does not alter the functional relationship. Mere support by the substrate (sheet) for the printed matter is not the kind of functional relationship necessary for patentability. The document of

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Gasper et al is capable of being an limited edition official stamp depending on the indicia printed on the sheet.

In regards to **Claims 19-22 and 30-33**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many types of indicia having characteristics as the “second indicia” as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

In regards to **Claims 12, 14, 18-23, 25, 29-34**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, the stamp of Gasper et al as modified by the St. Louis Dispatch is capable of being an “official postal” stamp depending on the indicia printed on the stamp.

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Response to Arguments

3. Applicant's arguments filed on May 30, 2003 have been fully considered but they are not persuasive.

In regards to applicant's arguments that the prior art reference is not directed to a limited edition stamp for postal usage, and that the prior art reference does not teach that the invention is not "visible under normal conditions, but is simply not readily observable", the examiner submits that the St. Louis Dispatch Article (1993) and Ottawa Citizen are now relied upon for disclosing an official limited edition stamp and limited edition postal postage stamp.

In regards to applicant's arguments that the applicant's invention is directed to a postage stamp, the examiner submits that the features upon which applicant relies (i.e., "postal stamp issued by official postal authority") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the examiner has interpreted the definition of "stamp" in its broadest sense. Webster's Dictionary defines "stamp" as a "printed paper affixed in evidence that a tax has been paid. Gasper et al does indeed disclose a "printed paper or document".

Webster's Dictionary also defines "observable" as being "visible". Furthermore, the applicant must note that the examiner must rely on the applicant's disclosure to properly determine the meaning of terms ("not visible") used in the claims. An applicant is entitled to be

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his or her own lexicographer, and in many instances will provide an explicit definition for certain terms used in the claims. Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention. If an applicant does not define a term in the specification, that term will be given its "common meaning" or its broadest reasonable interpretation consistent with the specification. In regards to the Gasper et al reference, something that is "not observable" means that it can not be seen, or is "not visible".

In conclusion Gasper et al teaches a printed document (stamp) which comprises first indicia being printed matter on a sheet and a second indicia (micro-dots) which is not capable of being scanned for reproduction (the micro-dots prohibit the document and indicia from being scanned) and is not visible under normal viewing conditions. The St. Louis Post-Dispatch is relied upon for disclosing an official limited edition stamp having unique indicia to disclose that it is one out a predetermined number.

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Conclusion

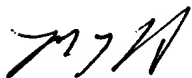
4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

October 6, 2003



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